Attorney Docket No.: RSW920010202US1 (7161-021U) **PATENT**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of	:	Customer Number: 46320
Bryan E. AUPPERLE, et al.	:	Confirmation Number: 6642
Application No.: 10/060,996	:	Group Art Unit: 3625
Filed: January 30, 2002	:	Examiner: Y. Garg

For: COOPERATIVE E-BUSINESS COMPLEX

REPLY BRIEF

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Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is submitted under 37 C.F.R. § 41.41 in response to the EXAMINER'S ANSWER dated March 8, 2007.

The Examiner's response to Appellants' arguments submitted in the Appeal Brief of January 8, 2007, raises additional issues and underscores the factual and legal shortcomings in the Examiner's rejections. In response, Appellants rely upon the arguments presented in the Appeal Brief of January 8, 2007, and the arguments set forth below.

The Examiner's initial response to Appellants' prior arguments in found in the paragraph spanning pages 8 and 9 of the Examiner's Answer and is reproduced, in part, below:

> All three inventions of Conklin, Horn and Lee are directed to e-commerce including conducting business transactions on Internet and therefore they are in the same field of endeavor.

The Examiner's statements remaining statements in the lower portion of page 7 and in the entirety of page 8 merely rehash the alleged the teachings of Conklin, Horn, and Lee. The Examiner then concludes in the sentence spanning pages 8 and 9, the following:

> Therefore, from the above evidences, it would be obvious to one of an ordinary skilled in the art that all the three prior arts of Conklin, Horn and Lee are directed to the common filed [sic] of endeavor that is of conducting web-based e-commerce of buying and selling products and services on Internet.

The Examiner's argument appears to be that any and all references that relates to the internet and selling are within the same field of endeavor. In response, Appellants note that the Examiner has an improperly broad concept as to what constitutes "the same field of endeavor."

As noted by Appellants in the last full paragraph on page 5 of the Appeal Brief, the teachings of Conklin and Horn are comparable to the average shopping mall, whereas the teachings of Lee are comparable to a Wall Street investment bank. In this regard, the considerable differences exists between Conklin/Horn and Lee as to the product/services being sold, how the product/services are sold, the manner in which the product/services are sold, and the type of provider/seller of the products/services being sold. The "raising of capital in global financial markets via the Internet," as taught by Lee, is not even close to being comparable to selling products/services over the internet.

Appellants, therefore, respectfully submit that Lee is non-analogous prior art that cannot be applied against the claimed invention. Whether a prior art reference is from a nonanalogous art involves (a) determining whether the reference is within the same field of endeavor and (b) determining whether the reference is reasonably pertinent to the particular problem with which

the invention is involved.[1] If the prior art is outside the inventor's field of endeavor, the inventor will only be presumed to have knowledge of prior art that is reasonably pertinent to the problem being addressed.[2] The Examiner is also charged to consider "'the reality of the circumstances' … in other words, common sense" to determine what field a person of ordinary skill in the art would reasonably be expected to look.[3]

As argued above, Lee is not within the same field of endeavor as either the teaching of Conklin/Horn or the claimed invention, which is also directed to a cooperative e-commerce complex.[4] Furthermore, the claimed invention is directed to, in part, solving the problem of be able to reduce startup costs, operating costs, and complexity of operating in a virtual mall environment so as to facilitate virtual store operation.[5] The teachings of Lee, however, are completely silent as to a virtual mall/cooperative e-commerce complex or how to reduce costs/complexity in such an environment. Thus, Appellants respectfully submit that Lee is non-analogous prior art that cannot be applied against the claimed invention.

On page 9 of the Examiner's Answer, the Examiner further asserted the following:

> Further, as disclosed in Horn and Lee, the prior art suggests providing ancillary services to the users, such as tax, payment processing, legal and translational services. It would be obvious to one of an ordinary skilled in the art at the time of the applicant's invention that business transactions of Conklin are conducted globally and the users of. Conklin system can require additional services such as translation of documents from one international language to another [example translating Chinese/French documents to English as suggested in Lee], tax assistance in dealing with the other country laws, as indicated in Horn and therefore, it would be obvious to one of an ordinary skilled in the art to modify Conklin to incorporate the teachings of Lee of providing legal/accounting/translational services to the users conducting global business transactions because that would make it convenient for them to deal and negotiate with buyers and sellers of other countries having different laws and languages. (emphasis added)

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[1] In re Clay, 23 USPQ2d 1058 (Fed Cir. 1992).
[2] In re Wood, 202 USPQ 171 (C.C.P.A. 1979).
[3] In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).
[4] A discussion of "virtual malls" is found on pages 2-4 of Appellants' disclosure.
[5] See the second full paragraph on page 6 of Appellants' disclosure.

By the Examiner's own statement, the Examiner points to the non-obviousness difference between the teachings of the applied prior art and the claimed invention. Appellants made the following argument in the first full paragraph on page 8 of the Appeal Brief:

> Absent from the teachings of the applied prior art and from the Examiner's analysis is a motivation to provide services to store operators in an e-business complex. Brokering services and/or goods between a store operator (i.e., business) and an end user (i.e., consumer), is well known. However, the Examiner has not established that one having ordinary skill in the art would consider, as being obvious, the brokering of services between store operators within an e-business complex. (emphasis added)

Referring to the underlined portion of the Examiner's statement, the Examiner recognizes that the prior art teaches that services can be provided to users. However, the Examiner's obviousness analysis does not address the obviousness of brokering services between store operators within an e-business complex, as claimed.

Reference is also made to the argument made by Appellants in the paragraph spanning pages 7 and 8 of the Appeal Brief, which is also relevant to this issue. Even if one having ordinary skill in the art were led to modify the combination of Conklin and Horn in view of Lee, the claimed invention would not result. The claimed invention is directed to providing store operators, within an e-business complex, with a catalog of professional services and brokering transactions between these store operators. Conklin and Horn describe store operators within an e-business complex, and Lee discusses a web-based system that provides users with the ability to raise capital via the internet. Appellants respectfully submit that to modify the combination of Conklin and Horn in view of Lee would not arrive at the claimed invention. Instead, even if one having ordinary skill in the art were led to modify Conklin and Horn and view of Lee, the web-based capital-raising system of Lee would be inserted into the e-business complete of the

combination of Conklin and Horn as just another store operator, which would not lead one having ordinary skill in the art to the claimed invention.

As to the remaining portion of the Examiner's analysis in the above-reproduced paragraph, Appellants note that the Examiner has failed to point to any factual support in the applied prior art for this analysis. Instead, the Examiner's asserted benefit appears to based upon what the Examiner's believes to be the benefits of the proposed combination and not a benefit that is taught by the applied prior art. In this regard, the Examiner has failed to identify a source in the applied prior art for the rationale to combine references in the reasonable expectation of achieving a particular benefit.[6]

On page 10 of the Examiner's Answer, the Examiner asserted the following:

> In the instant case, the examiner has established that the knowledge of a need and providing associated services, such as legal, accounting, tax and translational related services to the users engaged in business transactions of buying and selling products and services was available in the prior arts of Horn and Lee and therefore the examiner could properly rely on a conclusive of obviousness from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference.

Despite the Examiner's assertion that "the examiner has establish that the knowledge of a need ...," the Examiner has failed to establish where and how the Examiner has established knowledge of this need. Moreover, as already noted, the need for these additional services has not been established for the run-of-the-mill e-business complex. Instead, Lee describes a need for these services in the specific context of raising capital. For example, Lee teaches the following in paragraph [0004]:

> Generally, there are four types of participants involved in a capital raising process through the issuance of securities: (1) issuers; (2) financial intermediaries; (3) end investors; and (4) other intermediaries. Issuers include corporations, municipalities, foreign and domestic

[6] Smiths Industries Medical System v. Vital Signs Inc., 183 F.3d 1347, 51 USPQ2d 1415 (Fed. Cir. 1999).

> governments and their agencies and investment trusts. Financial intermediaries typically include banks, savings and loan institutions, insurance companies and brokerage firms. End investors are the eventual holders of the securities being issued. Other intermediaries include lawyers, accountants, auditors, paying agents, fiscal agents, trustees, and other entities or professionals that provide a service to the issuers or intermediaries.

Absent from the Examiner's analysis is a rationale as to why one having ordinary skill in the art would recognize that the teachings of Lee, which specifically apply to the raising of capital, would also apply to a virtual mall.

In the paragraph spanning pages 10 and 11, the Examiner further asserts the following:

> In the instant case, because the applicant opines that the arts of Conklin/Horn cannot be combined for economic reasons, that is the prior art of Conklin and Horn are related to e-commerce on the internet such as that of E-bay's non-auction store operators and that of Lee's prior art is directed to a web based method and system that facilitates business transactions including the raising of capital in global financial markets via the internet **is not same** as saying that it could not be done because skilled persons in art felt that there was some technological incompatibility that prevented their combination; only latter fact is telling on nonobviousness issue. (emphasis in original)

The Examiner's has misread Appellants' prior arguments. Appellants have not argued that one having ordinary skill in the art would not have combined the applied prior art in the manner suggested by the Examiner for economic reasons. Instead, Appellants have argued that it would not have been obvious to combine teachings as to product/services of these teachings when the product/services being sold, how the product/services are sold, the manner in which the product/services are sold, and the type of provider/seller of the products/services being sold are all completely different.

On pages 6 and 7 of the Appeal Brief, Appellants argued that providing access to service professionals is not the same as providing a catalog of professional services offered for sale. Thus, even if the Lee taught providing a list of service professionals that could be contacted by a user, this teaching still would not lead tot the claimed "catalog of professional services offered

for sale." The Examiner's response to this argument is found in the first full paragraph on page 11 of the Examiner's Answer:

> The applicant further argues (see Appeal brief page 6, line 15- page 7, line 4) that Lee does not disclose a " catalog of professional services offered for sale". The examiner respectfully disagrees. The examiner has interpreted the claimed phrase,: a catalog of professional services" as a record of professional services available for selection and Lee does suggest this (se [sic] paragraphs 0075 and 0076 and Fig.6) by stating that the user is allowed to select a legal counsel or other external professionals from a list of attorneys wherein the list of attorneys or a group of law firms describing the kind of legal work they do represent a catalog or a record or a list of available/offered professional services from which the user can select. The claim language does not limit on the methods or ways as how to select a professional service from the available catalog/record/list of attorneys providing professional services and therefore the applicant's arguments, "For example, the Examiner referred to paragraph [00751 of Lee, which teaches two different ways a user may seek and engage professional services. One option is... and another option is ", are not relevant. Such services, when selected are paid for by the user.

The Examiner's analysis continues to confuse a list of professionals (e.g., attorneys) with the claimed "catalog of professional services." A list of professionals and a list/catalog of professional services are not necessarily the same. A list of, for example, five different attorneys does not constitute a catalog of professional services since only a single service (i.e., legal) is being listed.

Moreover, Appellants note that the Examiner has improperly misrepresented the teachings of Lee. Specifically, the Examiner asserted that "wherein the list of attorneys or a group of law firms describing the kind of legal work they do represent a catalog or a record or a list." The teaching referred to by the Examiner is found in paragraph [0075] of Lee and reproduced below:

> The Document Services feature 75 offers a user the ability to seek and engage the external professional services (e.g., legal counsel and/or a translation service agency) necessary to properly execute a transaction. For example, a financial transaction typically requires external legal counsel to prepare the documentation and/or to provide legal expertise in structuring the transaction. Document Services 75 offers a user the ability to select legal counsel or other external professionals who have partnered onto the invention's system through two methods. A user in need of legal counsel, for example, may send an invitation to various attorneys 76 or a group of law firms describing the kind of legal work required and requesting an estimate of the legal fees. The user can then negotiate a fee with the law firms and select one or more firms to provide legal counsel. Alternatively, a user may hold a separate auction 76 on the system, through which legal counsel or a law firm(s) may bid for the work. Once the user and the selected legal counsel enter

> into an agreement, the law firm may upload template documents onto the invention's system and assist the user or participants to access and/or draft the appropriate documentation. (emphasis added)

As evident from the underlined passage above, the user describes "the kind of legal work required." The Examiner's improper misstatement is that Lee teaches that "attorneys or a list of firms [describe] the kind of legal work they do." Thus, the Examiner's analysis is predicated on an improper interpretation of the teachings of Lee.

For the reasons set forth in the Appeal Brief of January 8, 2007, and for those set forth herein, Appellants respectfully solicit the Honorable Board to reverse the Examiner's rejection under 35 U.S.C. § 103.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: May 2, 2007

Respectfully submitted,

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